



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/325,278	10/26/1994	LARS BJORCK	216764	6124

7590 12/31/2002

DAVID A. KALOW, ESQ.
KALOW AND SPRINGUT LLP
488 MADISON AVENUE, 19TH FLOOR
NEW YORK, NY 10022

EXAMINER

MINNIFIELD, NITA M

ART UNIT	PAPER NUMBER
----------	--------------

1645

DATE MAILED: 12/31/2002

54

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/325,278

Applicant(s)

BJORCK ET AL.

Examiner

N. M. Minnifield

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 48
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2002 has been entered.
2. Applicants' amendment filed September 30, 2002 is acknowledged and has been entered. Claims 14 and 15 have been amended. New claim 21 has been added. Claims 14-19 and 21 are now pending in the present application. All rejections have been withdrawn in view of Applicants' amendment to claims and/or comments set forth in the Amendment. However, new grounds of rejection have been set forth.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 14-19 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims, as written, do not sufficiently distinguish over proteins, as they exist naturally because the claims do not particularly point out any non-naturally occurring differences between the claimed products and the naturally occurring products. In the absence of the hand of man, the naturally occurring products are considered non-

statutory subject matter. *See Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). The claims should be amended to indicate the hand of the inventor, by insertion of "Isolated" or "Purified" if such language is fully supported by the specification. *See* MPEP 2105.

5. Claims 14-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kastern et al, 1990 in light of Sequence Search Result #2.

The claims are directed to proteins consisting essentially of SEQ ID NO: 1 or domains B1, B2, B3 or B4 (portions of SEQ ID NO: 1 as defined) in claim 14, a reagent kit and composition comprising the peptide and additive or carrier.

Kastern et al, 1990 disclose protein L, an immunoglobulin kappa light chain-binding protein that is expressed on the surface of *P. magnus* (abstract; p. 1217, column 1; p. 1221, column 1). Kastern et al disclose a reagent kit, the peptide and a detection reagent (materials and methods, p. 1217). Kastern et al disclose the cloning and sequence determination of the protein L (p. 1219, columns 1 and 2; figure 5). Kastern et al disclose the protein L in PBSA (materials and methods).

Attached Sequence Search Result #2 discloses that 99.7% match with the claimed SEQ ID NO: 1 and that it is set forth in the publication of Kastern et al, 1990.

With regard to claim 16, the binding to the various domains which bind to heavy chains of IgG chosen from (i), (ii), (iii), or (iv) would appear to be an inherent property since the domains are disclosed.

Since the Patent Office does not have the facilities for examining and comparing applicants' proteins with the proteins of the prior art reference, the burden is upon applicants to show a distinction between the material structural and functional characteristics of the claimed proteins and the proteins of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

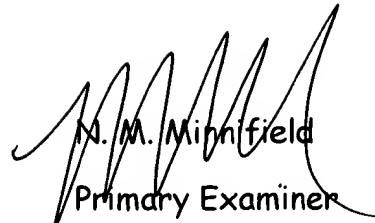
6. No claims are allowed.
7. Claims 17 and 21 would appear to be free of the prior art.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is 703-305-3394. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R.F. Smith can be reached on 703-308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Application/Control Number: 08/325,278
Art Unit: 1645

Page 5


N. M. Minnifield
Primary Examiner
Art Unit 1645

Nmm

December 30, 2002